

IN THE CLAIMS

Please add new claim 188 as follows:

188. (New) A method for receiving a digital rights management container containing electronic funds comprising:

(a) receiving a digital rights management container containing a digital representation of money, wherein the container containing a digital representation of money has at least one security attribute which precludes unauthorized access to the container; and

(b) entering security indicia, which allows access to the container containing a digital representation of money.

REMARKS

I. Status Of The Claims

Claims 1-187 are pending in this application.

Claims 1-15, 19-27, 55-61, 73-81, 100-112, 121, 122, 126, 128-130, 140-149, 155-159, 162-164, 172-174, 177-179 and 180-182 have been rejected under 35 U.S.C. 102(b) as being anticipated by Bocinsky (U.S. Patent No. 5,371,797).

Claims 16-18, 28-54, 62-72, 82-99, 113-120, 123-125, 127, 131-139, 150-154, 160, 161, 165-171, 176, and 183-187 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky.

Claims 1, 19, 28, 46, 55, 73, 82, 100, 109-111, 113, 115-117, and 119 are independent.

II. Rejection Under 35 U.S.C. § 102(b)

The Examiner has rejected independent claims 1, 19, 55, 73, 100, and 109-111 under 35 U.S.C. 102(b) as being anticipated by Bocinsky. However, Applicants submit that Bocinsky fails to disclose all aspects of the claimed invention.

For example, Bocinsky fails to disclose at least a digital representation of money that “has at least one security attribute which precludes unauthorized access” as stated in claim 19 (emphasis added) and similarly stated in independent claims 1, 28, 46, 55, 73, 82, 100, 109-111, 113, 115-117, and 119.

The Examiner, arguing that “the social security number taught by Bocinsky performs the same function as Applicants’ claimed invention, and the PIN number is considered as a password”, proposes that this matter is disclosed by Bocinsky. However Applicants respectfully disagree for at least the following reasons.

Bocinsky explains that “most ATM cash distribution systems have adopted the use of a personal identification number [PIN] … that must be provided by the customer in order to effect transaction using the card” (see Bocinsky, col. 1 ln. 26-30). Bocinsky further explains that a customer wishing to receive cash dispensed from an ATM enters his PIN, and that this PIN is forwarded in an encrypted form by a network computer “to the host computer at the bank that maintains the customer’s account” (see col. 2 ln. 9-10). Bocinsky indicates that the bank host computer “returns data to the network computer indicating whether or not the transaction is authorized” (see col. 2, ln. 15-17). According to Bocinsky, in the case where the transaction is authorized, “the network computer passes the authorization upstream allowing … the ATM to

dispense cash to the customer" (see col. 2 ln. 20-22).

Bocinsky discloses a further embodiment wherein "a service access number" such as "the customer's social security number" is initially provided, along with his PIN, by "a customer that wishes to register with a mail order retail establishment for immediate debit or secure credit card transactions" (see col. 4 ln 1-4 and 38-40). In this embodiment a customer, after registering, may use his service access number in place of his PIN for transactions (see Abstract, ln. 19-26).

In light of certain remarks made by the Examiner in previous Office Actions, Applicants believe that the Examiner views the authorization to dispense cash as a digital representation of money. However, Applicants submit that even if the authorization to dispense cash is a digital representation of money, it is not a digital representation of money that has at least one security attribute which precludes unauthorized access.

More specifically, Applicants note that Bocinsky fails to disclose that the PIN is used to satisfy a security attribute of the authorization to dispense cash; Although Bocinsky indicates that the host computer at the bank takes into account the PIN when deciding whether the transaction is allowable, he fails to indicate that accessing the authorization to dispense cash requires the PIN. Thus while Bocinsky may disclose that the PIN is necessary to receive the authorization to dispense cash, he fails to disclose that the PIN is necessary to access the authorization to dispense cash so received.

As noted above, Bocinsky discloses that a service access number (e.g., customer social security number) may be used by a registered customer in the manner of a PIN. Applicants

therefore believe that the comments made above with regard to the PIN apply to the service access number as well. Accordingly, Applicants submit that Bocinsky fails to disclose that the service access number is used to satisfy some security attribute associated with the authorization to dispense cash.

For at least these reasons, Bocinsky fails to disclose all aspects of independent claims 1, 19, 55, 73, 100, and 109-111. Accordingly, Applicants submit that these claims are in condition for allowance. Furthermore, claims 2-18, 20-27, 56-72, 74-81, 101-108, 112, 121, 122, 125, 126, 128-130, 140-149, 155-164, 170-174, and 177-182 that depend therefrom are thought to be in condition for allowance for at least the same reasons.

III. Rejection Under 35 U.S.C. § 103(a)

Independent claims 28, 46, 82, 113, 115-117, and 119 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky.

In order to establish a case of *prima facie* obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations” (see MPEP, section 2142). As explained above, Bocinsky fails to disclose a digital representation of money that “has at least one security attribute which precludes unauthorized access” as stated in claim 46 and similarly stated in independent claims 28, 82, 113, 115-117, and 119.

For at least this reason, Applicants submit that the Examiner fails to establish a case of *prima facie* obviousness against these claims. Accordingly, Applicants submit that these claims (28, 82, 113, 115-117, and 119) are in condition for allowance. As claims 29-45, 47-54, 83-99, 114, 118, 120, 123, 124, 127, 131-139, 150-154, 165-169, 175, 176, and 183-187 depend

therefrom, these claims are thought to be in condition for allowance for at least the same reason.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance for which action is earnestly solicited.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.



AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 3892-4000. **A DUPLICATE OF THIS DOCUMENT IS ATTACHED.**

Furthermore, in the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-noted Deposit Account and Order No.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: February 19, 2002

By:

Angus R. Gill
Registration No. P-51,133

Mailing Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 758-8400
(212) 751-6849 (Fax)